

APPLICANTS: Burke *et al.*  
U.S.S.N.: 09/467,628

The Examiner has restricted the present invention under 35 U.S.C. §121, stating that the inventions are distinct. The Examiner has classified Group I, claims 1–8, in class 435, subclass 7.8 and Group II, claims 9–12, in class 536, subclass 25.32. Specifically, the Examiner has alleged that, although Groups I and II are related as product and process of use, the groups are distinct because the labeled nucleic acid of Group II can be used as a hybridization probe.

Applicants traverse. 35 U.S.C. §121 states that “[I]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.” Thus, restriction is proper only if the inventions are “independent and distinct.” The M.P.E.P. §802.01 defines the term “independent” as follows:

The term “independent” (*i.e.*, not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process.

The M.P.E.P. §802.01 also defines the term “distinct” as follows:

The term “distinct” means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, **AND ARE PATENTABLE (NOVEL AND UNOBTAINABLE) OVER EACH OTHER** (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term “related” is used as an alternative for “dependent” in referring to subjects other than independent subjects.

Thus, the issue of patentability with respect to each other is not inherent merely because the Examiner has restricted the claims from each other. That is why M.P.E.P. §802.01, under the heading **DISTINCT**, sets forth the requirement in solid capital letters that the claims in each group **“ARE PATENTABLE (NOVEL AND UNOBTAINABLE) OVER EACH OTHER.”**

The present invention is directed to a **double stranded DNA that binds to the protein itself**. Thus, the present invention **cannot be used as a hybridization probe**. Applicants assert that the invention embodied within Group I as opposed to Group II is neither independent nor distinct, as there is “a disclosed relationship” between the claims in each group, which renders each set of claims **unpatentable and obvious** over one another.

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Accordingly, Applicants assert that the Examiner has not shown that the claims in Groups I and II "are patentable (novel and unobvious) over each other."

Furthermore, M.P.E.P. §803 requires that "if the search and examination of an entire application can be made without serious burden, the Examiner **must examine it on the merits, even though it claims distinct or independent inventions.**" The US Manual of Patent Classification states that a search in class 536, subclass 25.32 should also accompanied by a companion search in class 435. *See e.g.*, US Manual of Patent Classification, Class Definition, Class 536, subclass 25.32. Thus, the search of the an additional class and examination of the additional claims do not impose "a serious burden." Moreover, examination of this additional class might well reveal prior art pertinent to the related method claims, for it is not uncommon in patents on products to describe the processes for using the product. Manifestly, there is no serious burden on the Examiner to examine claims 9-12 along with provisionally elected claims 1-8.

### CONCLUSION

Reconsideration and withdrawal of the present restriction requirement and examination of the application is respectfully requested. However, should the requirement for restriction be made final, the Examiner is respectfully requested to rule that the claims in each group "are patentable (novel and unobvious) over each other." Should the Examiner have any questions, he is invited to telephone the undersigned at the number provided.

Respectfully submitted,



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Dated: October 9, 2001